



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,033	12/28/2000	John M. Eby	3063.0396-04	5788

22852 7590 07/02/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-11

Office Action Summary

Application No.

09/749,033

Applicant(s)

EBY ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 10, 6, 7, 9
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 96, 7, 9
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24 and 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- OK a. In claim 24, the location of the design layer is not clear.
- OK b. In claim 28, the location of the top coat is not clear.
- OK c. In claim 30, the location of the strengthening layer is not clear.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-26, 28 and 30-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidle et al. (US 4,273,819).

Schmidle discloses a floor covering having a backing sheet, foamable base having a chemically embossed portion, a layer having a printing ink composition, a wear layer having a mechanically embossed portion and a portion that has not been mechanically embossed, and a paper top layer in the order thereof (col. 13 and 14). The chemical embossed depth is greater than the mechanical embossed depth (see

Art Unit: 1774

Fig. 1 and 2). The chemically embossed portion is free from mechanical embossment (see Fig. 1 and 2). The wear layer comprises polyvinyl chloride, and is free from compounds that would lead to chemical embossing (col. 6, line 25). The claimed top coat is equivalent to the paper top layer, the claimed strengthening layer is equivalent to the backing sheet, and the claimed design layer is equivalent to the layer having the printing ink composition. Portions of the layer having the printing ink composition comprise no retarders. The printing ink composition is used for making the chemical embossment, in which portions of the ink composition contain retarder and other portions of the ink composition contain no retarders in order to provide the chemical embossment effect. Since applicants admit that they do not make the ink composition used for making the chemical embossment (page 7, last paragraph), claim 26 is rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al. (US 4,273,819) in view of Wang et al. (US 4,863,782) and Granata et al. (US 4,264,643).

Schmidle discloses a floor covering having a backing sheet, foamable base having a chemically embossed portion, a layer having a printing ink composition, a wear

Art Unit: 1774

layer having a mechanically embossed portion and a portion that has not been mechanically embossed, and a paper top layer in the order thereof (col. 13 and 14). The chemical embossed depth is greater than the mechanical embossed depth (see Fig. 1 and 2). The claimed top coat is equivalent to the paper top layer, the claimed strengthening layer is equivalent to the backing sheet, and the claimed design layer is equivalent to the layer having the printing ink composition. Portions of the layer having the printing ink composition comprise no retarders. The printing ink composition is used for making the chemical embossment, in which portions of the ink composition contain retarder and portions of the ink composition contain no retarders in order to provide the chemical embossment effect. Schmidle does not disclose tolyltriazole as an inhibitor in the ink composition.

Wang teaches a floor covering having a design layer having an ink composition containing tolyltriazole inhibitor (col. 10, lines 31-50).

Schmidle and Wang are analogous art because they are from the same filed of endeavor that is the floor covering art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Wang's inhibitor with the ink composition of Schmidle so as to modify foaming or blowing in the foamable base.

Schmidle does not disclose the top layer being made of acrylated urethane.

Granata teaches a vinyl floor covering having an acrylated urethane top coating (col. 14, line 5).

Schmidle and Granata are analogous art because they are from the same filed of endeavor that is the floor covering art. At the time of the invention, it would have been

Art Unit: 1774

obvious to a person of ordinary skill in the art to combine the acrylated urethane top coating of Granata with the invention of Schmidle so as to provide a floor covering having superior physical and chemical surface properties and characteristics.

Miscellaneous

7. The PTO 1449 for the IDS submitted on 02/14/2001 was not included. Please provide a copy.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS *BS*
June 27, 2002.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

